

## **REMARKS**

### **Status of Claims**

Claims 1-12, and 14-16 were pending in this application. By this Amendment, claims 1, 9, 15 and 16 have been amended and new claims 17-20 have been added. Claim 1-12 and 14-20 are presented for examination. Reconsideration is respectfully requested in view of the above amendments and the following remarks.

### **Rejection under 35 U.S.C. §103(a)**

Claims 1, 2, 7, and 8 were rejected under 35 U.S.C. § 102(b) as being anticipated by Baecker *et al.*, U.S. Patent No. 5,586,237 (hereinafter Baecker) and U.S. Patent No. 6,753,888 to Kamiwada *et al.* (hereinafter Kamiwada). This rejection is respectfully traversed.

With respect to claim 1, Baecker and Kamiwada fail to disclose or suggest, among other things, “displaying a graphical preview of at least one item on the outer appearance of the container, wherein the graphical preview is not a folder, and the graphical preview is generated by a thumbnail extractor based on the extensions associated with the at least one item.”

Baecker discloses a system that displays and manipulates depictions of icons representing the variable content of documents applications, or folders of files. U.S. Patent No. 5,586,237 (issued Dec. 17, 1996) col. 1, ll. 15-20. Baecker further discloses the depictions are displayed in either a static or animated form. *Id.* at col. 3, ll. 15-25. The objects represented by the icon depictions include documents, files, programs, and folders. *Id.* at col. 3, ll. 1-5. Baecker discloses a method to generate frames depicting folder contents or segments of a text document and segments of a graphical document. *Id.* at col. 6, ll. 40-65, col. 7, ll. 40-65 and col. 8, ll. 15-35.

Kamiwada discloses a three dimensional illustration of a folder having a directory structure. U.S. Patent No. 6,753,888 (issued Jun. 22, 2004) col. 5, ll. 5-10. The folder includes files and subfolders. *Id.* Additionally, a folder may include icons that represent the files contained in the folder. *Id.* When the file is an image, the image itself is displayed instead of the icon. *Id.* at col. 5, ll. 15. After a “copy” command related to the image is received and a pointer is stored on the clipboard, a thumbnail of the image is displayed on the foreground. *Id.* at col. 5, ll. 40-65. The thumbnail of the image is only generated when a specified condition is received from the input device and the image file has been placed on the clipboard. *Id.* at col. 6, ll. 10-45. The thumbnail image is placed on the foreground of the display and after the object associated with the thumbnail has been pasted, the thumbnail is destroyed. *Id.*

Unlike Baecker and Kamiwada embodiments of the invention generate graphical previews related to items within in a container. The graphical previews are displayed on the outer appearance of the container and are thumbnails. The graphical previews are thumbnails extracted from an item and represent an image associated with the item. The graphical previews do not represent folders because a preview of a folder on the outer appearance of a folder does not enable the user to quickly ascertain which items are associated with the folder.

It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention

being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Here, Baecker is directed to generating animated depictions related to the content of an object. On the other hand, Kamiwada is directed to facilitating a copy-and-paste functionality, and generating thumbnails associated with the objects that are pasted. Furthermore, Kamiwada fails to teach displaying a thumbnail on the outer appearance of the container. Kamiwada places the thumbnail on the foreground of the display. Combining the teachings of Baecker and Kamiwada would destroy the operation of the zoom-interface as disclosed by Kamiwada. Furthermore, Baecker would no longer operate as disclosed because the animations would not depict the contents of the file or folder. Although Baecker and Kamiwada disclose the use of graphical previews, the operation of the two references is too distinct to support a 35 U.S.C. § 103 rejection.

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Here, the Office Action contends “[o]ne would have been motivated to make such a combination because Baecker’s display on an interior of the folder instead of the exterior is a design choice, and could have as easily and with the same presented matter been displayed as in Kamiwada.” As noted above neither Kamiwada nor Baecker displays thumbnails on the outer appearance of the container. Additionally, neither Baecker nor Kamiwada suggests that it is desirable to display thumbnails on the outer appearance of a container.

Finally, in order to make out a *prima facie* case of obviousness, the references must provide all of the elements of the invention as claimed and a suggestion to combine the

disclosures of the various cited art references to make the claimed invention. See, *In re Geiger*, 815 F.2d 686,688 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Here, Baecker and Kamiwada fail to disclose among other things, displaying a graphical preview of at least one item on the outer appearance of the container, wherein the graphical preview is not a folder, and the graphical preview is generated by a thumbnail extractor based on the extensions associated with the at least one item. Accordingly, the rejection of claim 1, should be withdrawn for at least the reasons set forth above.

Claims 2, 7 and 8 depend from claim 1 and further define novel features of the claimed invention. Accordingly, for at least the reasons set for the above, claims 2, 7 and 8 are allowable by virtue of their dependence on claim 1.

#### **Rejection Under 35 U.S.C. §103(a)**

Claims 3-6, 9-12, and 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Baecker, Kamiwada and Poole, *Macword Mac OS 8.5 Bible*, (hereinafter Poole). This rejection is respectfully traversed.

Claims 3-6 depend from claim 1 and further define novel features of the claimed invention. Accordingly, for at least the reasons set for the above, claims 2, 7 and 8 are allowable by virtue of their dependence on claim 1.

With respect to claims 9, 14 and 15 Baecker, Kamiwada and Poole fail to disclose or suggest, among other things, “displaying a textual message in addition to the background appearance and the graphical preview, without displaying the collection of content items.” Poole

discloses various dialog boxes that present items matching search criteria entered in a dialog box. Lon Poole, Mac OS 8.5 Bible, 123, 159 (IDG Books Worldwide Inc. 1999). The items found may be sorted based on different sort criteria. *Id.* A navigation dialog and open dialog displays all items associated with a folder, and may generate previews. *Id.*

Unlike Poole, Baecker and Kamiwada embodiments of the invention generate graphical previews related to items contained in a container. The graphical previews are displayed on the outer appearance of the container. Furthermore, the display generated by embodiments of the invention does not list all items associated with the container.

Neither Baecker, Poole nor Kamiwada teaches or suggests a method that displays a textual message in addition to a background appearance and a graphical preview, without displaying all the collection of content items. Furthermore, the prior art fails to teach or suggest determining whether an item can be graphically previewed on the background appearance of a container. Poole teaches a dialog box that displays an icon and text; however, the dialog box is not a background appearance of a container. The combination of Kamiwada, Poole and Baecker fails to disclose or suggest displaying the graphical preview of the item on the background appearance of the container and displaying a text message, without displaying the collection of content items.

The combination of Baecker Poole and Kamiwada teaches away from the claimed invention. Baecker discloses that the display format is limited to either textual or graphical formats. Baecker does not disclose displaying both graphical and textual data simultaneously. Although Poole displays textual data there is no suggestion or motivation to modify Baecker to display both textual and graphical information. Moreover, Poole discloses a search dialog, navigation and open dialogs that display all items in a container. The combination of Poole with

Kamiwada and Baecker significantly changes the principle operation, animated depictions, disclosed by Baecker. Accordingly, the rejection of claims 9, 14 and 15 should be withdrawn for at least the reasons set forth above.

Claims 10-12 depend on claim 9 and further define novel features of the claimed invention. Accordingly, for at least the reasons set for the above, claims 10-12 are allowable by virtue of their dependence on claim 9.

With respect to claim 16, Baecker, Kamiwada and Poole fail to disclose or suggest, among other things, "displaying a graphical preview of at least one item on the outer appearance of the container, wherein the graphical preview is not a folder, and the graphical preview is generated by a thumbnail extractor based on the extensions associated with the at least one item."

Unlike Baecker, Poole and Kamiwada embodiments of the invention generate graphical previews related to items contained in a container. The graphical previews are displayed on the outer appearance of the container and are thumbnails. The graphical previews are thumbnails extracted from an item and represent an image associated with the item. The graphical previews do not represent folders because a preview of a folder on the outer appearance of a folder does not enable the user to quickly ascertain which items are associated with the folder.

Neither Baecker Kamiwada nor Poole singly or in combination teaches or suggests a method that displays a textual message in addition to a background appearance and a graphical preview on the background appearance, where the graphical previews are thumbnails extracted based on the extension of an item. The prior art does not suggest extracting thumbnails based on item extensions. Furthermore, as noted above Poole teaches away from Baecker's disclosure of determining whether the display format is iconic or textual. Therefore, the combination of the Kamiwada, Poole and Baecker fails to teach or suggest a graphical preview component capable

of displaying a textual message and a graphical preview of the contents of a container on the background of the container. Accordingly, for at least the reasons set forth above, claim 16 is allowable over the prior art.

To make a prima facie case of obviousness, the references must teach or suggest all the claim limitations. The combination of Kamiwada, Baecker and Poole fail to teach or suggest the limitations of claims 3-6, 9-12, and 14-16. Therefore, for at least the reasons set forth above, applicants respectfully request withdrawal of the §103 rejection.

Claims 17-20 are new claims and depend on claims 1, 9, 15 and 16 and further define novel features of the claimed invention. Accordingly, for at least the reasons set forth above, claims 17-20 are allowable by virtue of their dependence on claims 1, 9, 15, and 16.

**Conclusion**

Applicants respectfully submit that the section 103(a) rejections have been overcome and claims 1-12, and 14-20 are now in condition for allowance. Allowance of all pending claims is respectfully requested.

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated, since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a Petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 19-2112 referencing Attorney Docket No. MFCP.88143.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Monplaisir Hamilton', is written over a horizontal line.

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